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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,465	03/29/2004	Doyle D. Hendrickson	Hendrickson DivIII	2901
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SANTANGELO LAW OFFICES, P.C. 125 SOUTH HOWES, THIRD FLOOR FORT COLLINS, CO 80521				
			EXAMINER PARSLEY, DAVID J	
			ART UNIT	PAPER NUMBER
			3643	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/813,465

Applicant(s)

HENDRICKSON, DOYLE D.

Examiner

David J Parsley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3-29-04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Detailed Action

Terminal Disclaimer

1. The terminal disclaimer filed on 3-29-04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,203,418 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Specification

2. The disclosure is objected to because of the following informalities: on page 1 in line 4, "U.S. Patent No. _____, issued _____" should be - -U.S. Patent No. 6,722,969, issued April 4, 2004.

Appropriate correction is required.

Claim Objections

3. Claim 12 is objected to because of the following informalities: on line 3 "said thumb rest" should be - -a thumb rest- -. Appropriate correction is required.

Claim Rejections - 35 USC § 101

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4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 18 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In line 2 the limitation “a finger” positively recites a natural phenomena being a part of the human body.

Claim 28 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In line 2 the limitation “a finger” and in line 4 the limitation “a thumb” both positively recite a natural phenomena being a part of the human body.

Claim 29 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In line 2 the limitation “a thumb” and in line 3 the limitation “a finger” both positively recite a natural phenomena being a part of the human body.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

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invention. It is unclear from what the blade element is removable from as seen in line 5 of the claim.

Claims 2-18 depend from rejected claim 1 and include all of the limitations of claim 1 thereby rendering these dependent claims indefinite.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 8-11, 14-16 and 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,301,432 to Richardson et al.

Referring to claims 1 and 19, Richardson et al. discloses a cutting system/method comprising, a frame member – at 12,14, a blade body member – at 16,44, which is responsive to the frame member, a blade element – at 22, connected to the blade body member which is held by the blade body member wherein the blade element is removable – see figures 1-10, and has a straight cutting edge – at 24, and an end – see figures 1-10, an acute angle end point presented at the end of the blade element – see at 26, a pivot element – at 38,40 and/or 54,56, connected to the frame member and the blade body member which permits the blade body member to pivot with respect to the frame member and a blade retention cavity – at 28, on the frame member, wherein the blade retention cavity is configured to shield at least a portion of the cutting edge of

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the blade element when the blade body member is pivoted with respect to the frame member – see for example figures 1-10.

Referring to claims 2 and 20, Richardson et al. discloses the acute angle end point – at 26, at the end of the blade element – at 24, comprises a dual straight edge element – see for example figures 1, 6 and 8-10.

Referring to claims 3 and 21, Richardson et al. discloses a retaining element – at 18, that holds the blade element with respect to the blade body member – at 16,44, and wherein the retaining element is positioned approximately equidistant between the pivot element and the acute angle end point – see for example figures 1-10.

Referring to claim 8, Richardson et al. discloses the blade retention cavity – at 28 and a retaining element – at 18 or 54, and a blade body member – at 22. Further the limitations of the blade retention cavity adapted for insertion of a replaceable blade, and further comprising a retaining element wherein the replaceable blade is adapted to be held against the blade body member by the retaining element is considered functional limitations describing intended use of the device and therefore it is deemed that the prior art reference of Richardson et al., is capable of these functional elements in that the cavity – at 28 is large enough for a second replacement blade and the retaining element – at 18 or 54, is capable of retaining a replacement blade in proximity to the blade element – at 22 and thereby the Richardson et al. reference need not positively recite these claimed functional features.

Referring to claim 9, Richardson et al. discloses the retaining element – at 18, comprises a single retaining element – at 18.

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Referring to claim 10, Richardson et al. discloses the frame member – at 12,14, has an external frame surface – see for example figure 3, wherein the blade body member – at 16,44, has an external blade body surface – see for example figures 1 and 6, and wherein the external frame surface and the external blade body surface present aligned shapes when the blade body member – at 16,44, is pivoted with respect to the frame member – at 12,14, so that at least a portion of the cutting edge of the blade element is shielded by the blade retention cavity – at 28 – see for example at item 58 and figures 1-10.

Referring to claim 11, Richardson et al. discloses the frame member comprises a finger hole – see for example figure 2.

Referring to claim 14, Richardson et al. discloses a cut material centering element – at the rear of 22 and – at 42, behind at least a portion of the cutting edge – at 24 – see for example figures 1-10.

Referring to claim 15, Richardson et al. discloses the cut material centering element comprises a concave feature – see for example at the rear of 22 and at – 42 as seen in figures 1-10.

Referring to claim 16, Richardson et al. discloses the blade body member – at 16,44, is tapered and wherein the cut material centering element comprises the tapered blade body member – proximate the rear of item 22 and at 42, – see for example figures 1-10.

Referring to claim 18, Richardson discloses the frame member presents a spatial relation with respect to a cutting surface when used with a finger through the at least one finger hole in the frame member – at 12,14, and further comprising a substantially planer lifting edge – proximate 26, and a substantially planer retention edge – proximate 24, each form an angle with

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respect to the cutting surface – at 24,26, when the frame member is positioned in the spatial relation. Further, the limitations of the angle of the substantially planer lifting edge with respect to the cutting surface is less than 90 degrees while the angle of the substantially planer retention edge with respect to the cutting surface is about 90 degrees, is deemed functional language describing the intended use of the claimed apparatus and thus it is deemed that the device of Richardson et al., is capable of performing the claimed intended use in that any portion of the device of Richardson et al., can be moved into any position relative to the cutting surface and therefore the lifting edge can be positioned at an angle less than 90 degrees with the cutting surface while the retention edge is at an angle of 90 degrees with respect to the cutting surface.

Referring to claim 22, Richardson et al. discloses the cutting instrument has a blade back portion – at 22,24, proximate 40,54,56, and a frame front portion – see for example at 14 in figure 6, and wherein the step of pivoting the blade with respect to the frame member comprises the step of aligning at least a portion of the blade back portion with the frame front portion – see for example figures 1-10 where items 18,38,40 keep the blade in a certain alignment with the frame front portion.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-7 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson et al. as applied to claims 1 and 19 above, and further in view of U.S. Patent No. 579,655 to Saladee et al.

Referring to claims 4, 23 and 26, Richardson et al. does not disclose a releasable pivot lock to which the blade body member is responsive and which detachably prevents the blade element from pivoting with respect to the frame member. Saladee et al. does disclose a releasable pivot lock – at B,C,H,G,I, to which the blade body member – at F, is responsive and which detachably prevents the blade element – at F', from pivoting with respect to the frame member – at A,D, – see for example figures 1-8 and page 1 lines 58-87. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Richardson et al. and add the pivot lock of Saladee et al., so as to allow for the blade to be in an unexposed position when not deployed thus making the device safer to operate.

Referring to claim 5, Richardson et al. as modified by Saladee et al. further discloses the releasable pivot lock – at H,I, locks the blade element – at F', at three roughly orthogonal positions – see for example figure 5 of Saladee et al., where the blade element – at F', is orthogonal to the frame – at A,D, at multiple positions.

Referring to claims 6 and 24, Richardson et al. as modified by Saladee et al. further discloses the blade element – at F' of Saladee et al., and the blade body – at F, are pivoting elements, and wherein the releasable pivot lock – at B,C,H,I, comprises a locking mechanism – at B,C,H, to which the blade element is responsive, and a spring element – at I, which yiedably urges the locking mechanism – at B,C, against at least one of the pivoting elements – at F' – see for example figures 1-8 of Saladee et al.

Referring to claims 7 and 25, Richardson et al. as modified by Saladee et al. further discloses the blade element – at F' of Saladee et al., and the blade body – at F, are pivoting elements and wherein the releasable pivot lock – at B,C,H,G,I comprises, a pin – at G, to which the blade element is responsive, and a spring element – at I, which yieldably urges the pin against at least one of the pivoting elements – at F – see for example figures 1-8 of Saladee et al.

Claims 12, 17 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson et al. as applied to claims 1, 11, 19 or 28 above, and further in view of U.S. Patent No. 3,839,788 to Addis.

Referring to claims 12 and 28, Richardson et al. does not disclose a friction rotational restraint element located on the frame member adjacent at least one finger hole and substantially diametrically opposed with respect to the thumb rest. Addis does disclose a frictional rotational restraint element – at 30a,30b,42, located on the frame – at 12-16, adjacent at least one finger hole – proximate 22,24, and substantially diametrically opposed to the thumb rest – at 48 – see for example figures 11-13. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Richardson et al. and add the frictional restraint member of Addis, so as to allow for the components of the device to be securely held together.

Referring to claims 17 and 29, Richardson et al. does not disclose a thumb rest to which the frame member is responsive and which in use acts to cause a force, which is substantially perpendicular to at least a portion of the blade element. Addis does disclose a thumb rest – at 18b or 48, to which the frame member – at 12-16, is responsive and which in use acts to cause a force, which is substantially perpendicular to at least a portion of the blade element – see for example figures 11-13. Further, the limitations of when in use the thumb rest acts to cause a

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force which is substantially perpendicular to at least a portion of the blade element is an intended use recitation and it is deemed that the Addis device is capable of performing the claimed intended use in that the pressure applied to the thumb rest by the hand of the user produces a force which can be in any direction with respect to the blade. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Richardson et al. and add the thumb rest of Addis, so as to allow the user to have greater control of the blade element during operation of the device.

Referring to claim 27, Richardson et al. further discloses the cutting instrument has a blade – at 24,26 and a blade body member – at 16,44 having a slit – at 18, adapted for insertion of a blade – at 24,26, and retaining element 18 and/or 54. Richardson et al. does not disclose the steps of removing the blade from the blade body member, replacing the blade with a replacement blade, inserting the replacement blade in the slit in the blade body member and retaining the replacement blade in the blade body member. Addis does disclose the steps of removing the blade – at 28, from the blade body member – at 14a,42, replacing the blade with a replacement blade, inserting the replacement blade in the slit in the blade body member and retaining the replacement blade in the blade body member – see for example figures 11-14 and column 3 lines 40-45. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Richardson et al. and add the steps of replacing the blade of Addis, so as to allow for the blade to be replaced when it is damaged or worn out through excessive use.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5,581,895 to Jeffcoat. Richardson et al. further discloses the cutting edge – at 24,26, comprising a lifting edge

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proximate 26, and a retention edge – at 24. Richardson et al. does not disclose the lifting edge and the retention edge form an edge concave feature with respect to each other. Jeffcoat does disclose the lifting edge – proximate 30, and the retention edge – at 26, form an edge concave feature with respect to each other – see for example figures 1-2. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Richardson et al. and add the cutting edge of Jeffcoat, so as to allow the blade to perform multiple tasks.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to cutting devices in general:

U.S. Pat. No. 1,552,153 to Hartbauer – shows pivotable blade device

U.S. Pat. No. 4,203,214 to Fogle – shows pivotable blade device

U.S. Pat. No. 3,996,645 to Bordewick – shows multiple blade device

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J Parsley whose telephone number is (703) 306-0552. The examiner can normally be reached on 9hr compressed.

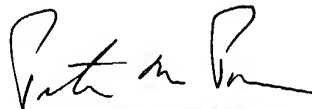
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (703) 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Parsley
Patent Examiner
Art Unit 3643



PETER M. POON
SUPERVISORY PATENT EXAMINER

